

By the present amendment, claims 14-21, 23 and 25 have been amended (a mark-up copy of the respective claims is enclosed, as required by rule 121). Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

### **I. Objection to Claim 25**

The Examiner has objected to claim 25 based on certain informalities. Applicant has amended claim 25 to overcome the Examiner's objection thereto. Accordingly, Applicant respectfully requests withdrawal of the objection to such claim.

### **II. Rejection of Claims Under 35 U.S.C. § 112**

The Examiner rejected claim 13 as lacking proper antecedent basis for the limitation "covering plane" and rejected claims 14-15, 17-21 and 23 under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. The aforementioned claims have been amended to overcome the Examiner's rejection thereto. It is respectfully submitted that the amended claims comply with all of the requirement of 35 U.S.C. § 112. Accordingly, withdrawal of this rejection to such claims is respectfully requested.

### **III. Rejection Over the Prior Art**

The Examiner has rejected claims 13-16, 18-21, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Stockl, U.S. Patent No. 3,699,926 (Stockl). Claim 17 is rejected under Stockl and further in view, respectively, of Myrvold, U.S. Patent No. 5,619,832 (Myrvold). Claim 22 is rejected under Stockl and further in view, respectively, Dungle, U.S. Patent No. 4,329,981 (Dungle). It is respectfully submitted that the aforementioned claims are patentable over the cited references.

The Examiner indicates that the mat, according to Stockl, forms third projections when pressure is applied to the mat. Such prior art can be distinguished from the invention, wherein the third projections are provided throughout the mat regardless of whether pressure is applied to the mat or not.

The foregoing novel features of the present invention is not disclosed or suggested in the prior art, including all of the prior art of record in this application.

Whereas the mat disclosed in Stockl is strongly bent by the applied pressure, the third projections of the mat, according to the invention, have the purpose (as discussed in the application) of limiting the bending of the mat

when pressure is applied to a certain area. The specification, on page 3, lines 4-7 discloses:

*The height of these projections is less than the height of those projections on the underside of the floor covering on which it rests in an unstressed state, so that it does not start to act until a specific load (a preset pressure) is applied.*

As a result, the third projections have a certain damping function. The totally flat portion of the mat, which is bent in the prior art, does not have this damping function. Thus, in the prior art, a light person can bend the mat to the ground in the same manner as a heavy person. In the mat of the invention, the third projections act as a very specific damping element.

Since all claim limitations must be considered in an obviousness determination, and since Stockl and the combination of Stockl with Myrvold or Dungal fail to disclose several of the important and recited elements and features of independent claim 13, and claims 14-23 that depend therefrom it is respectfully submitted the present invention, as defined by claim 13 and claims 14-23, is not rendered obvious by the Stockl or the combination of Stockl with Myrvold or Dungal and is, therefore, patentably defined over such prior art.

It is respectfully submitted that a prima facie case of obviousness has not been made. Even if Stockl, Myrvold or Dungal could be construed to disclose certain matter as contended by the Examiner, no disclosure or suggestion in such prior art can be found which should lead a skilled artisan to combine their various features. That separate features of different references may not properly be convinced, in the absence of some specific teaching that they should or could be so combined, is such well-settled law that it hardly need be repeated here. See, e.g., In re Newell, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1989), citing Smithkline Diagnostis v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988). In order to properly combine references to reach the conclusion that the claimed subject matter as a whole would have been obvious, there must have been some teaching, suggestion, or inference in either reference, or both, which would have led one of ordinary skill to combine the relevant teaching of the references. ACS Hospital System, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). No such teaching, suggestion or inference could be found in any of the prior art.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the

teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior art should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obvious.” In re Sponnoble, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

In view of the above, it is respectfully submitted that claim 13 patentably defines over the prior art and is, therefore allowable.


Claims 14-23, depend on claim 13 and are allowable for the same reason claim 13 is allowable and further because of specific features recited therein which, when taken above and/or in combination with features recited in claim 13, are not disclosed or suggested in the prior art.

## CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,

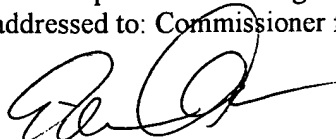


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## AMENDED CLAIMS

Application No.: 09/745,645

Applicant: Wolfgang Milewski

14. A floor covering according to claim 13, wherein the first projections [essentially] have [the shape of] a spherical segment.
15. A floor covering according to claim 13, wherein at least one of the second and third projections [essentially] have [a shape of] one of a flat square prism and a frustum.
16. A floor covering according to claim 13, wherein at least one of the second and third projections [essentially] have [a shape of] one of a spherical segment, a flat truncated cone, and a flat cylinder.
17. A floor covering according to claim 15, wherein the second projections have [the shape of the] one of a square prism and a frustum with rounded edges and [transitional] rounded areas adjoining the underside of the covering extending to the plane of the floor covering, and the third projections have the shape of a spherical segment.

18. A floor covering according to claim 13, wherein [dimensions] edge measurements of the second projections correspond to at least a distance [therebetween] between each of the second projections.
19. A floor covering according to claim 13, wherein [dimensions] edge measurements of the third projections are [essentially] less than a distance between each of the third projections.
20. A floor covering according to claim 19, wherein the [dimensions] edge measurements of third projections is less than  $\frac{3}{4}$  of the distance [therebetween] between each of the third projections.
23. A floor covering according to claim 13, wherein a height of the first projections is less than  $\frac{1}{3}$  of [their largest measurement] its diameter in the covering plane and a height of at least one of a second and third projections is in a range of between  $\frac{1}{5}$  and  $\frac{1}{2}$  of its [size measurement] diameter in the covering plane.
25. A floor covering according to claim [11] 13, wherein at least one of the perforations and the recesses have one of a circular cross-section and a cross-section of a segment.